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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,223	12/07/2000	Bily Wang	Harvateck 8948	9227

7590 07/21/2004

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EXAMINER

MITCHELL, JAMES M

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,223

Applicant(s)

WANG ET AL.

Examiner

James M. Mitchell

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's Admitted Prior Art, APA, (Fig 4).

APA (Spec. P. 1-2; Fig 4) discloses a surface mount semiconductor device a surface mount semiconductor device with two solid ("i.e. metal plates;" neither a liquid nor gas therefore a solid) C-shaped metal frames having top surfaces for contacting an electrode of a semiconductor device (A. Spec. P.1) and a bottom surface for mounting said semiconductor device on a motherboard, with an isolation gap (not labeled; i.e. space between frames/plates, 112, 112), a coating glue (13) and a focusing cup formed of said coating glue and a reflective coating (131) on said focusing cup for focusing a light beam, and wherein said two metal frames ("inner ends;" A. Spec. P.1) serve as electrodes for a diode and wherein said coating glue adheres said focusing cup (not labeled) to said top surfaces of said frames as a unitary structure (i.e. package one unit) without covering an area for contacting said electrode.

In regards to the process limitations of the "package being fabricated by preforming two solid generally C-shaped folded metal frames, " the prior art structure or product is the same as the claimed invention. "[E]ven though product-by-process claims

are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Furthermore, this invention has been elected by original presentation for prosecution on the merits of the device claims on November 26, 2003. Accordingly, any claim drawn to the process is directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant's arguments filed May 12, 2004 have been fully considered but they are not persuasive.

First, applicant contends that the invention is patentably distinct because APA does not have two solid pre-formed generally C-shaped folded metal frames, and cites to the benefits of not having holes in the frame. Secondly, applicant contends that APA does not disclose a coating glue adhering said focusing cup to a top surfaces of a frame as a unitary structure **without covering an area for contacting said electrodes**.

Examiner respectfully disagrees.

In response to applicant's first argument, holes in the frame of APA are not mutually exclusive of the frames being solid; no such limitation has been set forth in the

claim. Since the metal plate, frame of APA is neither in a liquid or gas stage, it is a solid material (i.e. identified by applicant as "metal plates" in its specification page 1), which happens to also include holes in it. Nevertheless since applicant has not provided a clear definition in the specification of its meaning for solid, during examination the claims are interpreted as broadly as their terms reasonably allow. M.P.E.P 2111.01. In this case, it is reasonable to interpret a material whose phase of matter that is neither liquid nor gas (i.e. "metal plates") as a solid.

As for the frames being pre-formed, as has been indicated in this and earlier office actions, the frame structure of APA is the same as that of applicant's claimed structure as such, the process limitations does not carry patentable weight.

Lastly, in response to applicant second argument, APA explicitly discloses the focusing cup adhered to top surface of the frames without covering an area for contacting said electrodes (Applicant Spec. P.1; "plates form the bottom of the focusing cup and serve to contact the electrodes of a diode"). Applicant's arguments are deemed unpersuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Mitchell whose telephone number is (571) 272-1931. The examiner can normally be reached on M-F 10:30-8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jmm
July 15, 2004


KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800